

REMARKS

Upon entry of the amendments in this paper, claims 1-24 will be pending in the above-identified application. Claims 9, 14, 19, and 24 are herein amended. No new matter is entered. It is respectfully submitted that this paper is fully responsive to the Office action mailed on September 22, 2009.

Claim Rejections - 35 U.S.C. §103

Claims 9-24 were rejected under 35 U.S.C. §103(a) as unpatentable over Applicants' disclosed prior art (APA).

In rejecting these claims, the Examiner acknowledged that the APA does not teach the setting value to have a power different from a center value of the predetermined intensity variable range (prior art sets the value at P_{cent}, fig. 2 S13). However, the Examiner asserted that it would have been obvious to adjust the automatic power control (APC) setting value to be a value other than the central power value as a matter of engineering design choice, which would allow for values of increased, or decreased, power to be used during varied operating conditions.

However, the Examiner has not presented a *prima facie* obviousness case with respect to his conclusion that it would have been an obvious matter of "design choice" to simply adjust the APC setting value. To set forth a *prima facie* obviousness case, evidenced motivation must be provided indicating why one skilled in the art would be motivated, lead, or suggested to modify an existing reference in view of another reference.

Also, it is improper to base a rejection on the claimed feature being merely a design choice. *See, In re Garrett*, 1986 Pat. App. LEXIS 8 (Bd. Pat. App. 1986), where the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences (“Board”) specifically stated: “the examiner has not presented any line of reasoning as to why the artisan would have been motivated to so modify the...structure, and we know of none. The examiner’s assertion...that the proposed modification would have been “an obvious matter of engineering design choice well within the level of skill of one of ordinary skill in the art” is a conclusion, rather than a reason.” Similar discussions can be seen in *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1985).

Here, the Examiner simply remarked that modifying the APA in the stated manner would allow for values of increased or decreased power to be used during varied operating conditions. However, the Examiner has not presented a proper line of reasoning sufficient to support his rejection. Accordingly, Applicants submit that a *prima facie* case of obviousness has not been properly presented.

However, to expedite prosecution and clarify the subject matter of the claimed invention, Applicants herein amend independent claims 9, 14, 19, and 24 to clarify the relation between “the power intensity setting range” and “the predetermined power intensity variable range,” and the relation between “the optimum temperature setting range” and “the predetermined temperature variable range.” Applicants submit that the APA does not disclose the subject matter as recited in currently amended claims 9, 14, 19, and 24.

Claims 14-18 were rejected for the same reasons given in the rejection to claims 9-13. Claim 24 was rejected for the same reasons given for the rejection to claims 9 and 19 above.

However, these claims are patentable over the APA for the reasons discussed above regarding claim 9.

In view of the above amendments and remarks (as well as the remarks in Applicants' previously filed remarks), Applicants request favourable reconsideration of claims 9-24.

Conclusion

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP


Darrin A. Auito

Attorney for Applicants

Registration No. 56,024

Telephone: (202) 822-1100

Facsimile: (202) 822-1111

DAA/rer